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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,535	08/24/2001	Lori Tassone Holmes	KCC-16,221	2474

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EXAMINER

STEPHENS, JACQUELINE F

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 12/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/939,535

Applicant(s)

HOLMES ET AL.

Examiner

Jacqueline F. Stephens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/19/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4, 6, 9-12, 14-20, 26-33, 35-43, 57, 58, 60-63, 65, 68-70, 72-77 is/are pending in the application.
- 4a) Of the above claim(s) 1, 2, 4, 6, 9-12, 14-20, 27-33 and 35-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26, 43, 57, 58, 60-63, 65, 68-70 and 72-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 9/19/06 have been fully considered and they are not persuasive.

Applicant argues the present invention includes a lower layer that can be smaller than the upper layer and the lower layer can be cut into a smaller, specifically shaped piece or cut into several pieces and placed in areas most in need of high absorption capacity, thereby minimizing bulk thickness in areas in which high absorption capacity is not needed. Applicant argues it would not have been an obvious matter of design choice to provide the upper and lower layers of Everett with the claimed dimensions because Everett specifically teaches away from Applicant's claimed dimensions. Applicant cites page 7, lines 31-33 as support for this position. However, Everett is not deemed to teach away from Applicant's claimed dimensions. Everett teaches various sizes for the upper layer, and teaches the layers can be designed, individually or in combination, to provide an improved balance of intake and distribution of fluids by modifying the physical configuration of the components (page 8, lines 1-9). Everett further teaches the desirability of reducing bulk thickness in the areas most in need of high absorption capacity by modifying the size of the layers in the crotch region (page 13, lines 1-35). Because Everett solves the same problem and teaches a variety of sizes for the layers, the examiner maintains it is within the level of one of ordinary skill in

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the art to modify the sizes of the layers suitable for the intended use, desired absorbent capacity, and /or fluid wicking properties.

In response to applicant's argument that Osborn discloses a single discontinuous layer and Everett fails to disclose any discontinuous layer, thus the combination is not proper; the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, the examiner has relied on Osborn for a teaching of a segmented absorbent core for the benefit of providing independent segments each able to move in the Z-direction without constraints and allowing the core to conform to the shape of the body of the wearer.

Applicant argues the term "continuous" is not superfluous and specifically that the language in claim 43 conveys that the upper layer is continuous and the lower layer is discontinuous. Applicants cite page 13, lines 11-15 of the specification for support of the term discontinuous as it differentiates the multiplicity of individual pieces from a continuous length. However, the examiner maintains the length of the upper layer is continuous from one point to the next point. The claim language does not require the layer to be continuous throughout the length of the layer. Although the claims are

interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 26, 57-58, 60-63, and 68 are rejected under 35 U.S.C. 103(a) as being

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unpatentable over Everett et al. WO 99/17695.

As to claim 26, Everett discloses an absorbent material comprising: an upper layer 48 including pulp fluff and superabsorbent material and a lower layer 50 including pulp fluff and superabsorbent material (page 20, line 26 through page 21, line 24); wherein the absorbent material has a thickness in a range of between 0.5 and 7.5 mm (page 13, lines 9-12), and an absorbent capacity between about 14 and 40 grams 0.9 w/v% saline solution per gram of absorbent material (page 23, lines 11-19), and the lower layer has a greater density than the upper layer (page 21, lines 10-24; page 78, line 6-9 and page 80, lines 3-5. Everett discloses the upper layer comprises between 20 and 75wt%, which includes a component of the range of between 10 and 80% superabsorbent (page 78, lines 15-16). Everett does not disclose the upper layer comprising a bottom surface encompassing an entire surface of the upper layer that faces the lower layer, the lower layer having a top surface encompassing an entire surface of the lower layer that faces the bottom surface of the upper layer wherein the bottom surface area of the upper layer is greater than the top surface area of the lower layer. However, it would have been an obvious matter of design choice to provide the upper and lower layers with the claimed dimensions, since such a modification would have involved a mere change in the size of a component. Applicant has not provided criticality in the cited passages page 13, lines 11-15 or page 27, lines 17-20 for a difference in the surface area of the layers. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

As to the limitations of the upper layer being drum -formed and the lower layer being air laid, these limitations are directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

As to claim 57, Everett discloses an upper layer of density 0.03 g/cm^3 - $.4 \text{ g/cm}^3$ (page 78, lines 7-8). Everett discloses the lower layer has a density of not less than about 0.1 g/cm^3 and not more than about 0.3 g/cm^3 (page 80, lines 3-4).

As to claim 58, Everett discloses the upper layer comprises between 20 and 75wt%, which includes the range of between 20 and 70% superabsorbent (page 78, lines 15-16).

As to claim 60, see page 13, lines 9-12.

As to claim 61, Everett discloses the absorbent material has an absorbent

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capacity of at least 16 grams w/v% saline solution per gram of absorbent material (page 23, lines 11-19).

As to claim 62, Everett discloses two or more layers (page 25, lines 34-35.

As to claims 63, Everett discloses a plurality of layers on the upper layer (page 79, claim 12).

As to claim 68, Everett discloses various forms of the absorbent article, see page 6, lines 16-25 directed toward an intended use of the article.

6. Claims 43, 65, 69-70, 72-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Everett in view of Osborn, III.

As to claims 43 and 65, Everett discloses an absorbent garment comprising: a chassis defining a waist opening and first and second leg openings; the chassis including a liquid-permeable body side liner, an absorbent assembly, and a substantially liquid-impermeable outer cover layer (page 15, lines 9-18). Everett discloses an absorbent material comprising: an upper layer 48 including pulp fluff and superabsorbent material and a lower layer 50 including pulp fluff and superabsorbent material (page 20, line 26 through page 21, line 24); wherein the absorbent material has a thickness in a range of between 0.5 and 7.5 mm (page 13, lines 9-12), and an absorbent capacity between about 14 and 40 grams w/v% saline solution per gram of absorbent material (page 23, lines 11-19), and the lower layer has a greater density

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than the upper layer (page 21, lines 10-24; page 78, line 6-9 and page 80, lines 3-5).

The limitations of the upper layer being drum -formed and the lower layer being air laid are directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

Everett does not disclose the lower layer comprises a plurality of separate pieces placed in desired location of the absorbent assembly. Osborn discloses an absorbent product with a segmented absorbent core for the benefit of providing independent segments each able to move in the Z-direction without constraints and takes into account the front-to-back differences in the shape of the body of the wearer and thus allows a more accurate and comfortable fit (Osborn, Abstract and col. 2, lines 13-20). One of ordinary skill in the art would be motivated by the teachings of Osborn to modify the lower layer to have a segmented core for the benefits taught in Osborn. As to the limitation of a continuous length of the upper layer, applicant has not given any guidance or definition in the specification or claims of the term "continuous" that distinguishes the amended claims over the prior art of record. Specifically, "continuous length", given the broadest interpretation can mean any length of the layer between two points. Therefore, without any clarification of the term "continuous length", this term is

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considered to be synonymous with "length" and the amendment does not change the scope of the claims.

As to claim 69, Everett discloses an upper layer of density 0.03 g/cm^3 - $.4 \text{ g/cm}^3$ (page 78, lines 7-8). Everett discloses the lower layer has a density of not less than about 0.1 g/cm^3 and not more than about 0.3 g/cm^3 (page 80, lines 3-4).

As to claim 70, Everett discloses the upper layer comprises between 20 and 75wt%, which includes the range of between 20 and 70% superabsorbent (page 78, lines 15-16). Everett discloses the upper layer comprises between 20 and 75wt%, which includes a component of the range of between 10 and 80% superabsorbent (page 78, lines 15-16).

As to claim 72, see page 13, lines 9-12.

As to claim 73, Everett discloses the absorbent material has an absorbent capacity of at least 16 grams 0.9 w/v% saline solution per gram of absorbent material (page 23, lines 11-19).

As to claim 74, Everett discloses two or more layers (page 25, lines 34-35).

As to claims 75 and 76, the limitations of the upper layer being drum -formed and the lower layer being air laid are directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

As to claims 77, Everett discloses a plurality of layers on the upper layer (page 79, claim 12).

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F. Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jacqueline F Stephens
Primary Examiner
Art Unit 3761

November 27, 2006